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ARNOLD & PORTER LLP
ATTN: IP DOCKETING DEPT.
555 TWELFTH STREET, N.W.
WASHINGTON DC 20004-1206

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OFFICE OF PETITIONS

In re Application of	:
Goto et al.	:
Application No. 08/915,004	: Decision Denying Petition for
Filed: August 20, 1997	: Patent Term Extension
For: NOVEL PROTEINS AND METHODS	:
FOR PRODUCING THE PROTEINS	:

The above-identified application has been forwarded to the undersigned for consideration on the "Petition under 37 CFR 1.182 or 1.183," which was received on May 16, 2006.

The petition is **denied**.

Background

Petitioner filed a petition as a "Petition to the Commissioner" on November 7, 2005, for an extension of the patent term. Petitioner requested an additional 194 days of patent term extension due to delays in the Office for suspensions for potential interferences to increase the patent term extension from 1,631 days to the maximum of 5 years or 1,825 days. On March 17, 2006, the petition was dismissed and the patent term extension was reduced to 0 days.

Petitioner states that the above-identified application was filed on August 20, 1997, and allowed on September 7, 2005, but was delayed due to suspensions in prosecution due to interference proceedings. Petitioner further states that the application was suspended from November 23, 1998 through September 7, 2005, and argues the patent should be extended by 1,825 days for the period of suspension. Petitioner states that the Office mailed the first suspension for a potential interference on November 23, 1998. Petitioner states that following the initial suspension, the application was suspended again for potential interferences on August 31, 1999, June 8, 2000 and March 21, 2001. Petitioner states that during this time status inquiry letters were submitted on June 8, 1999, July 16, 1999, August 4, 1999, March 8, 2000, April 10, 2000, May 10, 2000, December 11, 2000, March 5, 2001, July 31, 2002, October 7, 2002, December 20, 2002, March 5, 2003 and May 27, 2003. In addition, petitioner states that a Petition to the Commissioner requesting status information was filed on June 19, 2003 and that the decision (on December 16, 2003) stated that the application was still suspended for a potential interference. Petitioner states that after several more status inquiries filed on

April 28, 2004, and July 1, 2004, a Notice of Allowance was mailed on September 7, 2005. The Notice of Allowability and Issue Fee Due mailed on September 7, 2005 indicated that the patent term extension was 1,631 days. Petitioner filed a petition on November 7, 2005 requesting that the patent term extension should be 1,825 days, however the petition was dismissed in the Office's decision mailed March 17, 2006, and the patent term extension was reduced to 0 days.

Petitioner states that under 37 CFR 1.701(c)(1), the patent term should be extended the number of days in the period beginning on the date prosecution in the application was suspended by the Office due to interference proceedings and ending on the date of the termination of the suspension. Petitioner contends that applicant is entitled to 1,825 days of patent term extension. Petitioner asserts that the Office's position cannot be sustained because it completely ignores the Office's publication entitled "United States Patent Practice in a Post Uruguay Round World." For support of his position, Petitioner relies on the phrases "applications suspended by the Office due to interference determination but not involved in interference may be extended for period of suspension" and "patent term extensions compensate for delays beyond control of applicant" in the Office's publication. Petitioner asserts that while the Office professes that there was no interference proceeding regarding this application, no other explanation is provided for the almost seven-year delay. Petitioner asserts that he understands that the suspension is part of the Office processing pursuant to 35 U.S.C. 135(a) and requests clarification if otherwise.

Petitioner notes that the Office's decision mailed March 17, 2006 stated that the Board of Patent Appeals and Interferences (BPAI) would be involved in determining whether or not an interference would be declared in this application. Petitioner asserts that proceedings by the BPAI in determining whether an interference will be declared are interference proceedings under 35 U.S.C. 135(a), thus the Office cannot maintain that the suspensions initiated by the Office were not interference proceedings. Petitioner indicates that the Office interprets 37 CFR 1.701(c)(1)(ii) to apply only to await the result of an interference in another application. Petitioner asserts that 37 CFR 1.701(c) is for the number of delays for each interference that the application was involved, and also for the number of days during the suspension period due to interference proceedings under 35 U.S.C. 135(a) not involving the application, e.g., the delay before an interference is declared or the delay where an interference is eventually not declared. Petitioner asserts that the Office has interpreted 37 CFR 1.701(c)(1)(ii) to only apply to situations so rare, as to not even be in the Manual of Patent Examining Procedure (MPEP). Petitioner asserts that the patent term extension for this application should be the maximum of 5 years regardless of whether the suspensions were due to a potential interference or to await the result of an interference in another application. Petitioner respectfully notes that the PAIR records indicate that the suspension on March 21, 2001 was due to an interference in another application. Petitioner also notes that contrary to the PAIR record, the decision mailed on March 17, 2006 expressly states that the suspension "was not to await the result of an interference in another application."

Applicable Statutes and Regulation

35 U.S.C. 135 Interferences

(a) Whenever an application is made for a patent which, in the opinion of the Director, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the Director shall give notice of such declaration to the applicants, or applicant and patentee, as the

case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability. Any final decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent and Trademark Office of the claims involved, and the Director may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved in the patent, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation by the Patent and Trademark Office. ***

35 U.S.C. 154. Contents and term of patent (in effect from June 8, 1995 to May 28, 2000)

(b) TERM EXTENSION.-

(1) INTERFERENCE DELAY OR SECRECY ORDERS.-If the issue of an original patent is delayed due to a proceeding under section 135(a) of this title, or because the application for patent is placed under an order pursuant to section 181 of this title, the term of the patent shall be extended for the period of delay, but in no case more than 5 years.

(2) EXTENSION FOR APPELLATE REVIEW.-If the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years. A patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

(3) LIMITATIONS.-The period of extension referred to in paragraph (2)-

(A) shall include any period beginning on the date on which an appeal is filed under section 134 or 141 of this title, or on which an action is commenced under section 145 of this title, and ending on the date of a final decision in favor of the applicant;

(B) shall be reduced by any time attributable to appellate review before the expiration of 3 years from the filing date of the application for patent; and

(C) shall be reduced for the period of time during which the applicant for patent did not act with due diligence, as determined by the Commissioner.

(4) LENGTH OF EXTENSION.-The total duration of all extensions of a patent under this subsection shall not exceed 5 years.

37 CFR 1.701 Extension of patent term due to examination delay under the Uruguay Round Agreements Act (original applications, other than designs, filed on or after June 8, 1995, and before May 29, 2000).

(a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to:

(1) interference proceedings under 35 U.S.C. 135(a); and/or

(2) the application being placed under a secrecy order under 35 U.S.C. 181; and/or

(3) appellate review by the Board of Patent Appeals and Interferences or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision reversing an adverse determination

of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review.

(b) The term of a patent entitled to extension under paragraph (a) of this section shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3), and (d) of this section, to the extent that these periods are not overlapping, up to a maximum of five years. The extension will run from the expiration date of the patent.

(c)(1) The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) with respect to each interference in which the application was involved, the number of days, if any, in the period beginning on the date the interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(ii) the number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Patent and Trademark Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

(2) The period of delay under paragraph (a)(2) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) the number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) the number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 1.193 in the application under secrecy order and ending on the date the secrecy order and any renewal thereof was removed;

(iii) the member of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy order and ending on the date the secrecy order and any renewal thereof was removed; and

(iv) the number of days, if any, in the period beginning on the date of notification under § 5.3(c) and ending on the date of mailing of the notice of allowance under § 1.311.

(3) The period of delay under paragraph (a)(3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal Court in an appeal under 35 U.S.C. 145.

(d) The period of delay set forth in paragraph (c)(3) shall be reduced by:

(1) any time during the period of appellate review that occurred before three years from the filing of the first national application for patent presented for examination; and

(2) any time during the period of appellate review, as determined by the Commissioner, during which the applicant for patent did not act with due diligence. In determining the due diligence of an applicant, the Commissioner may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review.

(e) The provisions of this section apply only to original patents, except for design patents, issued on applications filed on or after June 8, 1995, and before May 29, 2000.

Opinion

35 U.S.C. § 154(b)(as amended by the “Uruguay Round Agreements Act,” enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000.

35 U.S.C. § 154(b)(as amended by the “American Inventors Protection Act of 1999,” enacted November 29, 1999, as part of Public Law 106-113) provides for patent term adjustment for administrative delays in applications filed on or after May 29, 2000.

The above-identified application was filed on August 20, 1997. Accordingly, the application is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b) in effect on June 8, 1995. The current provisions of 35 U.S.C. § 154(b) became effective on May 29, 2000 and do not apply because the current version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000. Pursuant to 35 U.S.C. § 154(b) in effect on June 8, 1995, an applicant can receive patent term extension only if there was an appellate review, interference or a secrecy order delay as set forth in the statute. The statute limits the Office’s authority to grant patent term extension to only those situations stated in the statute.

In order to implement 35 U.S.C. 154(b) (in effect between June 8, 1995 and May 28, 2000), the Office promulgated 37 CFR 1.701(c)(1), which, consistent with the statute, requires an interference proceeding under 35 U.S.C. 135(a) to be eligible for patent term extension. Although prosecution was suspended in the above-identified application, the suspensions were due to a potential interference either with or involving one or more other applications. The suspensions were not for the reason that the subject application was involved in an interference, or to await the result of an interference proceeding in another application. As a result, the provisions of 37 CFR 1.701(c)(1)(i) do not apply as the subject application was not involved in an actual interference. Additionally, the provisions of 37 CFR 1.701(c)(1)(ii) do not apply because this section applies to suspensions by the “Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application,” and in this instance there were no such other interference proceedings. Therefore, Petitioner’s arguments that he is entitled to patent term extension for the periods of suspensions under 37 CFR 1.701(c)(1)(ii) are not persuasive.

Petitioner’s argument that 37 CFR 1.701(c)(1) does not require the delay to be due an actual “interference proceeding” is not persuasive. The statute clearly states that a patent is entitled to term extension if issuance of the patent is delayed due to a “proceeding under section 135(a).” According to the statute, patent term extension (for interferences purposes) can only be accrued by applications for delays due to a proceeding under 35 U.S.C. 135(a) (interference proceeding). An interference under 35 U.S.C. 135(a) does not begin until the BPAI declares an interference, an interference is a proceeding conducted before the BPAI. See MPEP, 8th edition, revision 3, §§ 2300.01 and 2301.02 or MPEP, 8th edition, revision 4, §§ 2301 - 2301.02. Petitioner’s argument that the only reasonable interpretation of 37 CFR 1.701(c)(1) is intended to apply not only to actual interference proceedings, but also to the proceedings which are specifically instituted to facilitate the declaration of an interference, such as the suspension in the above-identified application is not persuasive because the statute clearly limits accrual of patent term extension to delays due to a “proceeding under section 135(a).” Petitioner’s argument that the Office’s interpretation of 37 CFR 1.701(c)(1)(ii) is so rare as not to even be provided for in the MPEP (MPEP 709) is not persuasive. Applications which are suspended to await the outcome of an interference are discussed in the MPEP. See MPEP 8th edition, revision 3, § 2315.01 or MPEP 8th edition, revision 4, § 2307.03.

Petitioner's argument that the Office's publication supports his position is not persuasive. With respect to patent term extensions for applications not involved in interference, the publication is clear that an interference proceeding must still take place because of the line "Interference Proceedings Under § 135." With respect to Petitioner's argument concerning patent term extension compensating for delays beyond control of the applicant, patent term extension does not compensate applicant for all delays but only those authorized by the statute. Petitioner's argument that there is no other reason for the almost seven-year delay besides an interference proceeding is not persuasive. The Office Actions indicate that the application was suspended for a potential interference. Petitioner's argument that PAIR indicates that the suspension on March 21, 2001 was to await the result of an interference in another application is not persuasive. While PAIR indicates that the suspensions were to await the result of an interference, the Office action mailed on March 21, 2001 clearly indicates that the suspension was due to a potential interference. The entry in the PAIR record, which caused patent term extension to be calculated was a clerical entry error. Furthermore, all of the Office Actions and all of the status inquiries submitted by applicant indicated that the suspensions were for a potential interference. Petitioner's argument that the decision mailed by the Office on December 16, 2003, which indicated that the BPAI would be involved in determining whether or not an interference would be declared and that the application was forwarded to the BPAI, is not persuasive. Even accepting Petitioner's argument that the application was forwarded to the BPAI sometime after December 16, 2003, the application was returned to the Technology Center in January 2004 according to Petitioner's status inquiry received on April 28, 2004, without an interference being declared. Because an interference was not declared, patent term extension (for interferences purposes) cannot be accrued. Petitioner contends that it is not fair give the instant application zero (0) days of patent term extension due to the suspensions, as there is no other explanation for the long delay. While the delay in the allowance and issuance is regretted, the Office has no authority to grant an extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154(b). It is noted that Congress (in 1999) did not make the patent term adjustment provisions in current 35 U.S.C. 154 retroactively available.

Decision

The prior decision which refused to grant a petition under 35 U.S.C. 154(b) and 37 CFR 1.701 for patent term extension for the delayed issuance of the patent for the above-identified patent application has been reconsidered. For the reasons stated herein, and in the previous decision, however, a patent term extension in this case cannot be granted under 35 U.S.C. § 154(b) and 37 CFR §§ 1.183 and 1.701. Therefore, the petition is **denied**.

The Office's electronic record (Patent Application and Location Monitoring system (PALM)) has been adjusted to show that zero (0) patent term extension has been accrued to the above-identified application.

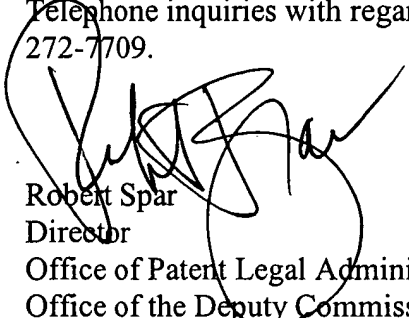
The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. *See* 35 U.S.C. § 41(a)(7). Accordingly, as authorized, the required \$400 fee for the petition has been charged to petitioner's Deposit Account.

The issuance of the patent has not been delayed due to the processing of this petition since all the review and analysis associated with the issuance of this decision has been performed from retrieving documents found in the Office's image file wrapper (IFW) system.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



Robert Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy